

REMARKS/ARGUMENTS

In the Office Action dated October 5, 2005, the Examiner: 1) rejected claims 1-5, 7, 15-16, 18-20, and 22-25 under 35 U.S.C. § 102(b) as being anticipated by German reference DE 299 07 467, hereinafter *Hsieh*; and 2) rejected claims 1-7, 15-20, and 22-26 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,436,992, issued to *Over et al.* (hereinafter *Over*). The Applicants respond as follows. In the following discussion references made to particular text within *Hsieh* are made with reference to corresponding U.S. Patent No. 6,044,731.

Rejections based on *Hsieh*

The examiner rejected claims 1-5, 7, 15-16, 18-20, and 22-25 as being anticipated by *Hsieh*. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). If a single element is not found in the prior art reference, the claims are not anticipated. Additionally, the Federal Circuit has held that "[t]o anticipate, every element and limitation of the claimed invention must be found in a single prior art reference arranged as in the claim." *Brown v. 3M*, 265 F.3d 1349, 60 U.S.P.Q.2d 1375 (Fed. Cir. 2001). Thus, an invention is anticipated only when the same device having all the elements contained in the claim limitations, is described in a single prior art reference. Applicants submit that the rejected claims are not anticipated by *Hsieh* because *Hsieh* fails to disclose each and every limitation of the rejected claims. In particular, *Hsieh* does not disclose a pawl having a first teeth portion having a first center of curvature and a second teeth portion having a second center of curvature located at a position different from the first center of curvature.

The written disclosure of *Hsieh* does not contain any teachings as to the center of curvature of the pawl. The Examiner relies solely on Figures 4 and 5 of *Hsieh* to teach a pawl having two teeth portions with centers of curvature located at different positions. Applicants acknowledge that drawings and pictures can anticipate claims if they clearly show the structure which is claimed. *In re Mraz*, 455 F.2d 1069, 173 USPQ 25 (CCPA 1972); See also MPEP 2125. However, Applicants contend that the drawings of *Hsieh* do not clearly show a pawl having two teethed portions each having a distinct center of curvature located at a different position. *Hsieh*, Figures 1-6. Thus, Applicants submit that claims 1-5, 7, 15-16, 18-20, and 22-25 are not anticipated by *Hsieh* because *Hsieh* fails to teach each and every element of these claims.

Hsieh teaches a double-reversible ratchet wrench comprising a body (1), a ratchet wheel (2), a stop block (3), and an adjustment member (5). *Hsieh*, Col. 1, lines 62-65; *Hsieh*, Figures 2 and 4. The stop block (3) is a smoothly arched member mounted in the body (1), having two toothed portions (31) on its front side. *Hsieh*, Col. 2 lines 13-16; *Hsieh*, Figures 2 and 4. When assembled, adjustment member (5) can be turned between a first position and a second position. *Hsieh*, Col. 2, lines 55-58.

While adjustment member (5) is in the first position, one of the toothed portions (31) of the stop block (3) is meshed with the toothed portion (21) of the ratchet wheel (2), enabling the ratchet wheel (2) to be turned in the forward direction or to run idle in the reverse direction. *Hsieh*, Col. 2, lines 58-64; *Hsieh*, Figure 4. When adjustment member (5) is moved to the second position, the other toothed portions (31) of stock block (3) is meshed with the toothed portion (21) of the ratchet wheel (2), enabling the ratchet wheel (2) to be turned in the reverse direction or to run idle in the forward direction. *Hsieh*, Col. 2, line 64-Col. 3, line 3; *Hsieh*, Figure 5.

The Examiner states that, because the Figures of *Hsieh* show one teeth portion in “full engagement” with the gear wheel while the other teeth portion is not engaged with the gear wheel, the teeth portions must have different centers of curvature. It is well settled that arguments based on drawings not explicitly made to scale in issued patents are unavailing. See *Nystrom v. Trex Company, Inc.*, 424 F.3d 1136, 1149 (Fed. Cir. 2005) (“The district court erred in not properly applying the principles set forth in our prior precedents that arguments based on drawings not explicitly made to scale in issued patents are unavailing.”); *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000) (The disclosure gave no indication that the drawings were drawn to scale. “[I]t is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.”); See also MPEP 2125. If a drawing is not to scale, geometric relationships and proportions between different elements in such a drawing may or may not be accurate and are subject to varying interpretations. See *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956 (Fed. Cir. 2000); See also *Nystrom*, 424 F.3d at 1149 (“*Hockerson-Halberstadt* indicated our disfavor in reading precise proportions into patent drawings which do not expressly provide such proportions.”). Because, *Hsieh* does not disclose that the drawings are to scale and contains no written disclosure as to the centers of curvature of the two toothed portions (31) of stop block

(3), the drawings of *Hsieh* can not be solely relied upon to anticipate claims 1-5, 7, 15-16, 18-20, and 22-25. Therefore, the Examiner's rejections based on the drawings of *Hsieh* should be withdrawn.

To the extent that the drawings of *Hsieh* indicate any information regarding the centers of curvature of the teeth of the stop block, the drawings are ambiguous and are subject to multiple interpretations. If a reference is subject to more than one interpretation, such reference should not be used as the basis for an anticipation rejection. *In re Turlay*, 304 F.2d 893, 898-899 (C.C.P.A. 1962) (The CCPA noted that the drawings in the cited reference had more than one interpretation and therefore the CCPA could not agree that the cited reference anticipated the applicant's appealed claim. Further, the CCPA stated “[i]t is well established that an anticipation rejection cannot be predicated on an ambiguous reference.”).

As an example of an alternate interpretation of the drawings of *Hsieh*, Applicant contends that the Figures of *Hsieh* show a stop block having a single radius of curvature. As illustrated below, the Applicant contends that a single arc can be drawn along the toothed portions (31) clearly showing a single center of curvature for both toothed portions (31) of stop block (3).

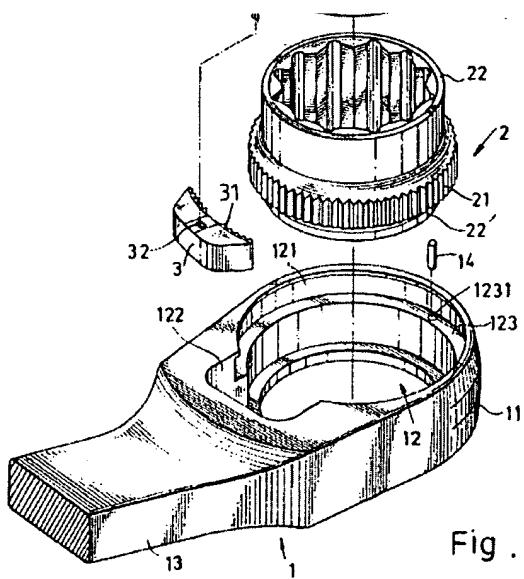
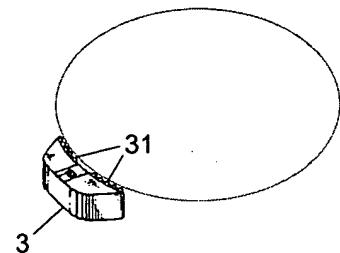


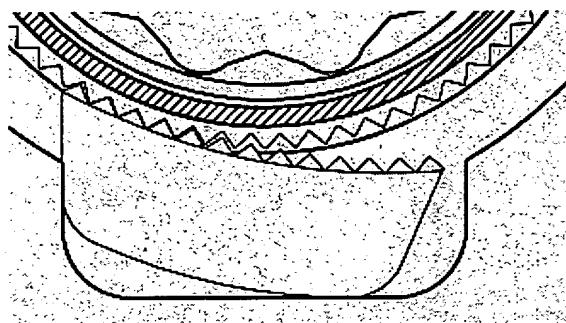
Fig . 2

Hsieh, Figure 2



Hsieh, Figure 2 (Amended by Applicants)

In order to further illustrate that *Hsieh* shows a stop block having a single center of curvature, Applicant generated the drawing shown below that shows a magnified image of the engagement between a single center of curvature pawl and a gear wheel where the teeth on the pawl have a larger radius of curvature than the teeth on the gear wheel. As can be seen in the drawings, the pawl teeth on one side are meshed with the gear wheel teeth, while the pawl teeth on the opposite side are not engaged at all.



Single center of curvature pawl with larger radius of curvature than gear wheel

The above drawings make it clear that the Figures of *Hsieh* can be reasonably interpreted as showing a stop block with teeth having a single center of curvature where the radius of curvature of the pawl is larger than the radius of curvature of the gear wheel. Further, the Examiner's reliance on the Figures to show that one teeth portion of the pawl in "full engagement" with the gear wheel is not supported by the specification. In describing the interface between the pawl and the gear wheel, *Hsieh* states that the stop block (3) is "meshed" with the ratchet wheel. See *Hsieh*, Col., 2, Lines 58-67. "Meshed" simply describes the stop block and the ratchet wheel being in working contact, which may be much less than the fully engaged stated by the Examiner. The nature of the drawings of *Hsieh* makes it impossible to precisely determine the amount of engagement between the stop block and the ratchet wheel but there is no support in the specification that the teeth are in "full engagement."

Since the determination of the centers of curvature of toothed portions (31) of the stop block (3) of *Hsieh* are subject to different interpretations, Applicant contends *Hsieh* cannot be relied on to **clearly** show two toothed portions having centers of curvature located at different

positions. Therefore, the anticipation rejections of claims 1-5, 7, 15-16, 18-20, and 22-25 based on the drawings of *Hsieh* should be withdrawn.

To anticipate a claim, each and every element of the claim must be found, either expressly or inherently described, in a single prior art reference. In addition, a claim "cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled." *Rasmussen v. SmithKline Beecham Corp.*, 413 F.3d 1318, 1325 (Fed. Cir. 2005) (quoting *Elan Pharm., Inc. v. Mayo Found.*, 346 F.3d 1051, 1054 (Fed. Cir. 2003)). Enablement for anticipation purposes requires that the cited reference sufficiently describe the claimed invention so as to have placed the public in possession of that invention. *In re Donohue*, 766 F.2d 531, 533 (Fed. Cir. 1985); *In re Samour*, 571 F.2d 559, 562 (C.C.P.A. 1978). The proper test is "whether one skilled in the art to which the invention pertains could take the description of the invention in the printed publication and combine it with his own knowledge of the particular art and from this combination be put in possession of the invention on which a patent is sought." *In re LeGrice*, 301 F.2d 929, 935 (C.C.P.A. 1962); See *In re Donohue*, 766 F.2d 531, 533 (Fed. Cir. 1985) ("Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his own knowledge to make the claimed invention.").

Applicants contend that *Hsieh* does not provide a sufficient description that would enable one skilled in the art to be put in possession of the claimed invention. In particular, Applicants contend that *Hsieh* does not describe a first teeth portion having a first center of curvature and a second teeth portion having a second center of curvature located at a position different from the first center of curvature. Each of claims 1-5, 7, 15-16, 18-20, and 22-25 include limitations requiring that the pawl have two teeth portions having distinct centers of curvature that are located at different positions.

Hsieh does not make any mention or inference to its stop block (3) having two toothed portions each having a center of curvature located at a different position. Further, the drawings of *Hsieh* do not include any indication of the locations of the center of curvature of the toothed portion. Still further, for at least the reasons discussed above, Applicants contend that drawings do not clearly show a pawl having the claimed features. Since *Hsieh* fails to teach or disclose two toothed portions having centers of curvature located at different positions, *Hsieh* could only serve as an enabling reference for anticipation purposes if one skilled in the art had knowledge of this limitation at the time of invention. However, the Examiner has failed to provide any objective evidence or reasoning that this limitation would be known by one skilled in the art at the time of invention. Further, the Examiner has failed to

cite any prior art reference(s) that show a pawl with two toothed portions having centers of curvature located at different positions. Thus, Applicants submit that one skilled in the art would not be in possession of a pawl having two toothed portions having centers of curvature located at different positions. Therefore, *Hsieh* does not satisfy the enablement requirement necessary to anticipate any of the pending claims.

Rejections based on Over

The Examiner rejected claims 1-7, 15-20, and 22-26 as being anticipated by *Over*. *Over* teaches a reversible ratchet wrench having two “independent and separate floating pawls.” *Over* Col. 3, Lines 50-51. The two pawls are “substantial duplicates” and include one face with extending teeth and a curved face opposite the teeth. *Over* Col. 3, Lines 51-63. The teeth are complementary in shape to a ratchet member and the curved face matches the curvature of a wall of the recess in which the pair of pawls are contained. *Id.* The opposed faces of the two pawls have shallow bores, which accept two ends of a helical coil spring that urges the two pawls apart. *Over* Col. 4, Lines 7-11. A lever engages pins protruding from the top of each of the two pawls and selectively moves one pawl at a time into and out of engagement with the ratchet. *Over* Col. 4, Lines 41-44.

Claim 1 has been amended to claim a pawl comprising a body having a side with a plurality of pawl teeth disposed thereon. Claim 15 has been amended to include a pawl comprising a pawl body having a side with a plurality of pawl teeth facing the gear wheel teeth. Claim 23 has been amended to include a pawl comprising a body having a first side with a plurality of pawl teeth engaging the gear wheel teeth.

Each of independent claims 1, 15 and 23 now claims two portions located on a side of a body. Although *Over* discloses two teeth portions with centers of curvature located at different positions, the teeth portions are disposed on “a pair of independent and separate floating pawls.” *Over* Col. 3, Lines 50-51. Therefore, the teeth portions of *Over* are not located on a side of a body but on two “independent and separate” bodies. Even under an interpretation of the “independent and separate floating pawls” of *Over* as a single pawl, *Over* does not teach or disclose a pawl comprising a body with a side having two teeth portions with different centers of curvature. Therefore, claims 1, 15, and 23 are not anticipated by *Over* and the rejections should be withdrawn. Claims 2-7, 16-20, 22, and 24-26 depend from one of claims 1, 15, or 23 and therefore are also not anticipated by *Over*.

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Conclusions

During the course of these remarks, Applicant has at times referred to particular limitations of the claims which are not shown in the applied prior art. This short-hand approach to discussing the claims should not be construed to mean that the other claimed limitations are not part of the claimed invention. They are as required by law. Consequently, when interpreting the claims, each of the claims should be construed as a whole, and patentability determined in light of this required claim construction.

If the Examiner has any questions or comments regarding this communication, he is invited to contact the undersigned to expedite the resolution of this application.

Respectfully submitted,



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